



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/621,081

07/16/2003

Michael Ruth

MRE-001

1243

21323

7590

10/03/2006

TESTA, HURWITZ & THIBEAULT, LLP  
HIGH STREET TOWER  
125 HIGH STREET  
BOSTON, MA 02110

EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/621,081	RUTH, MICHAEL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This response is in regards to applicant's communication filed on July 16, 2003, wherein claims 1-22 are currently pending.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 7/16/2006 and 4/19/2004 are being considered by the examiner.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12, 14-20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Mukund (PG Pub. 2003/0069983).

Referring to Claims 1-11:

Mukund discloses a corporate governance system comprising:

(a) a receiving module that receives information from an internal and external source (Mukund [0006], "web-based system")

(b) a memory module (Mukund [0043] "disk storage")

Art Unit: 3629

(c) a compliance module in communication with the receiving module (Mukand [0004], "compliance assurance")

(d) an account review module (Mukand fig. 3, item 96)

(e) an employee benefits module (Mukand [0045] and [0058] "employee")

Referring to Claim 12:

Mukand discloses a computerized method for facilitating corporate governance comprising:

(a) receiving information from a service provider (Mukund [0006], "web-based system");

(b) facilitating compliance with at least one corporate governance standard for at least one of an accounting service, a legal service, a banking service, a corporate service, an insurance service, a health, medical, and welfare benefit service, and a government regulatory service (Mukand [0045] and [0058] "employee").

Referring to Claim 14:

Mukand discloses verifying the compliance with the at least one corporate governance standard (Mukand fig. 3, item 96).

Referring to claim 15:

Mukand discloses wherein the receiving step further comprises receiving information from at least one of an accounting service, a legal service, a banking service, a corporate service, an insurance service, and a health, medical, and welfare benefit service (Mukand [0045] and [0058] "employee" and fig. 7).

Art Unit: 3629

Referring to Claim 16:

Mukand discloses facilitating securing of insurance coverage (Mukand [0002]) (Examiner considers Human Resources to encompass employee benefit programs and these also include insurance).

Referring to Claim 17:

Mukand discloses evaluating at least one of an insurance policy, an insurance carrier, an insurance agency, an insurance salesperson, a brokerage firm, a banking policy, a bank, a brokerage carrier, and a brokerage policy (Mukand [0058] "payroll").

Referring to Claim 18:

Mukand discloses facilitating development of an employee benefits program in compliance with the at least one corporate governance standard (Mukand [0002]) (Examiner considers Human Resources to encompass employee benefit programs.).

Referring to Claim 19:

Mukand discloses enabling a client to view information associated with at least one of the at least one corporate governance standard and the service provider (Mukund [0006], "web-based system")

Referring to Claim 20:

Mukand discloses wherein the facilitating compliance with the at least one corporate governance standard further comprises facilitating compliance with a

Art Unit: 3629

plurality of corporate governance standards (Mukand [0002], "applicable laws and regulations")

Referring to Claim 22:

Mukand discloses a corporate governance system comprising:

(a) means for receiving information from a service provider (Mukund [0006], "web-based system");

(b) means for storing at least one corporate governance standard (Mukand fig. 3, item 20);

(c) means for facilitating compliance with the at least one corporate governance standard for at least one of an accounting service, a legal service, a banking service, a corporate service, an insurance service, and a health, medical, and welfare benefit service (Mukand [0045] and [0058] "employee").

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 3629

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukand in view of Young et al. (PG Pub. 2003/0018487) (Hereinafter referred to as Young).

Referring to Claim 13:

Mukand does not explicitly disclose facilitating training to comply with the at least one corporate governance standard.

However, Young teaches facilitating training to comply with the at least one corporate governance standard (Young [0166]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the web based compliance assurance system of Mukand with the education and awareness system of Young in order to human error element out of corporate compliance while assuring employees are fully trained and educated to make any assessments necessary.

Referring to Claim 21:

Mukand discloses a computerized method for facilitating corporate governance comprising:

- (a) receiving instructions about at least one corporate governance standard from a client (Mukund [0006], "web-based system")

Art Unit: 3629

(c) facilitating compliance with the instructions (Mukand [0007])

(d) verifying the compliance of the instructions (Mukand fig. 3, item 96).

Makund does not explicitly disclose using the instructions to train a user.

However Young teaches using the instructions to train a user (Young [0166]). It

would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate into the web based compliance assurance system of

Mukand with the education and awareness system of Young in order to human

error element out of corporate compliance while assuring employees are fully

trained and educated to make any assessments necessary.



Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jan Mooneyham  
Primary Examiner  
Art Unit 3629

